

### **REMARKS/ARGUMENTS**

Claims 1-80 are pending in the present application.

This Amendment is in response to the Final Office Action mailed March 3, 2004. In the Office Action, the Examiner rejected claims 1-5, 21-25, 41-45 and 61-65 under 35 U.S.C. §102(e); and claims 6-7, 9-17, 26-27, 29-37, 46-47, 49-57, 66-67 and 69-79 under 35 U.S.C. §103(a). Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Rejection Under 35 U.S.C. §102 and §103***

1. In the Office Action, the Examiner rejected: (1) claims 1-5, 21-25, 41-45 and 61-65 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,357,004 issued to Davis ("Davis-004"); (2) claims 6-7, 9-17, 26-27, 29-37, 46-47, 49-57, 66-67 and 69-77 under 35 U.S.C. §103(a) as being unpatentable over Davis-004 in view of U.S. Patent No. 4,319,233 issued to Ermolovich ("Ermolovich"); (3) and claims 8, 28, 48 and 68 under 35 U.S.C. §103(a) as being unpatentable over Davis-004 in view of Ermolovich and further in view of U.S. Patent No 5,844,986 issued to Davis ("Davis-986"). Applicants respectfully traverse the rejections and contend that the Examiner has not met the burden of establishing a prima facie case of anticipation and/or obviousness.

Applicants reiterate the arguments presented in the response filed on January 14, 2004. In particular, Applicants contend that Davis-004, Ermolovich and Davis-986, taken alone or in any combination, does not disclose expressly or inherently, suggest, or render obvious (1) a secure environment for an isolated execution mode, (2) a processor operating in one of a normal execution mode and the isolated execution mode, and (3) a communication storage to exchange security information with the processor in the isolated execution mode in a remote attestation.

In the Office Action, the Examiner states that the features upon which applicant relies are not recited in the rejected claim (s) (Office Action, page 2, paragraph 3). The Examiner then states that "limitations from the specification are not read into the claims", citing In re Van Guens, 988 F.2d. 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicants respectfully disagree.

First, the features recited by the Applicant in the previous response are to provide the Examiner an opportunity to review the specification. Those are intended to help interpreting the claim language. They are not limitations read into the claims.

Second, the Examiner apparently misread Van Guens. In Van Guens, the claim in question recites a magnet assembly with a uniform magnetic field. The applicant in Van Guens argues that the uniform magnetic field limitation must be interpreted in light of the specification which discloses the magnetic field uniformity for NMR or MRI imaging. In rejecting this argument, the Court states that the "short answer is that [the] claim ... is not expressly limited to NMR or MRI apparatus". In re Van Guens, 26 USPQ2d at 1059. The court further states that the applicant cannot read an NMR limitation into the claim to justify his argument as to the meaning of the uniform magnetic field. The Van Guens rule, therefore, is only applicable if the claim does not expressly recite the limitation.

Here, the limitation of "an isolated execution mode" is recited in the claim. This limitation should be interpreted according to the specification as discussed above.

Claims should be interpreted consistently with the specification, which provides content for the proper construction of the claims because it explains the nature of the patentee's invention. Renishaw, 158 F.3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998). The Renishaw court explicitly states that when "a patent applicant has elected to be a lexicographer by providing an explicit definition in the specification for a claim term, .. the definition selected by the applicant controls." Renishaw, 48 USPQ2d 117, 1121. During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification". See MPEP 2111. "When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art". In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 13320, 1322 (Fed. Cir. 1989). In In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) the Court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from "reading limitations of the specification into a claim," to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim". See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ 2d 1023, 1027-28 (Fed. Cir. 1997) (The Court held

that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would in interpreting claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.")

In the Office Action, the Examiner further states that Davis-4 discloses a communication storage and a remote attestation, citing Davis-4 at Col. 3, lines 15-30 ("..stored within [a] second electronic system [and certification authority]"). The Examiner apparently equates the "communication storage" in the claimed invention with the "second electronic system" in Davis-4. Applicants respectfully disagree.

First, the "second electronic system" in Davis-4 is not a communication storage to exchange security information with the processor in the isolated execution mode. It is merely another system that contains the public key of a certification authority (Davis-4, col. 3, lines 24-26). Second, the second electronic system does not correspond to the address space as recited in the claim, by virtue of its being a second system separate from the first system associated with the private key. Third, as discussed above, Davis-4 does not disclose an isolated execution mode.

Therefore, Applicants believe that independent claims 1, 21, 41, 61 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicants respectfully request the rejections under 35 U.S.C. §112, 35 U.S.C. §102(e), and 35 U.S.C. §103(a) be withdrawn.

**Conclusion**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: April 14, 2004

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